

UNITED STATES PATENT AND TRADEMARK OFFICE

Response: Since the redacted copy of an application for publication must be submitted via EFS (and not via the mail), the certificate of mailing practice set forth in § 1.8 is inapplicable to the submission of a redacted copy of an application for publication. In view of the significant burden that filing a redacted copy of an application for publication places on the Office, the Office considers it appropriate to require such an applicant to provide the Office with the document necessary for processing the application by means that ensure that such documents are promptly received in the Office.

See Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57048 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63, 85 (Oct. 10, 2000) (final rule) (comment 68 and response).

The salient point remains that a registered practitioner is expected to be aware of all of the provisions of the rules of practice. Petitioner's argument that the USPTO should have stated in 37 CFR 1.8(a)(2) that the provisions of 37 CFR 1.8(a) do not apply to 37 CFR 1.217 does not warrant a waiver of the provision of 37 CFR 1.217(e) that 37 CFR 1.8 does not apply to 37 CFR 1.217. See Gustafson v. Stange, 227 USPQ 174, 175 (Comm'r Pats. 1985) (that 37 CFR 1.304 does not indicate that the provisions of 37 CFR 1.8(a) does not apply to 37 CFR 1.304 is immaterial as 37 CFR 1.8(a) provides the provisions of 37 CFR 1.8(a) does not apply to 37 CFR 1.304 and a registered practitioner is expected to know all of the rules of practice).

Petitioner argues 37 CFR 1.217(c) does not require that the hard copies be received by the Office or "filed" in the Office, within the sixteen month deadline. Petitioner argues that the rule only requires that the hard copies be "concurrently submitted in paper" and that the hard copy submission was timely concurrently submitted because the hard copies were submitted on the same day as the timely electronic filing with a § 1.8 certificate of mailing. The rule states that the "redacted copy of the application in compliance with this section" must be filed within sixteen months after the earliest filing date for which a benefit is sought to have a publication of a redacted application. Since the hard copies must be concurrently submitted, they must also be filed within the sixteen month time frame, as it is part of the submission to the Office. Since 37 CFR 1.217(e) specifically excludes the provisions of § 1.8 to the provisions of this section, it does not apply for the submission of the hard copies.

*Petition under 37 C.F.R. § 1.183*

Suspension of the rules under 37 C.F.R. § 1.183 may be granted only "[i]n an extraordinary situation, when justice requires ...." The rule places the determination of whether a situation is "extraordinary," and whether justice requires waiver, within the discretion of the Commissioner of Patents and Trademarks. *Nitto Chem. Indus. Co. v. Comer*, 39 USPQ2d 1778, 1780 n.4 (D.D.C. 1994). The facts presented on the record do not establish an extraordinary situation within the meaning of § 1.183. Petitioner has not established any special circumstances or equities that would require suspension of the rules in the interests of justice.

There is no adequate showing that petitioner was faced with a conflict between two rules, as the rules are not in conflict. 37 CFR 1.217, publication of a redacted copy of an application, specifically excludes the use of § 1.8 to timely respond to the time periods set forth therein. Petitioner has not provided any evidence that she was prevented from filing the hard copy of the redacted papers before the expiration of the sixteen month period or that the papers could not have been filed by express mail (37 CFR 1.10). Thus, in weighing the contribution of Petitioner toward her failure to realize that the certificate of mailing practice

does not apply to the time periods set forth for redacted publications against any other contributing factor, waiver of the exclusion of § 1.8 practice for redacted publications of 37 C.F.R. § 1.217(c) pursuant to 37 C.F.R. § 1.183 in this situation is not justified. Additionally, the lack of any harm to the Office due to applicant's failure to appreciate that a certificate of mailing could not be used does not demonstrate that justice requires waiver of the rules of practice. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence. *United States v. Lockheed Petroleum Servs.*, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

The application is being returned to Technology Center 2100 for further examination.

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